



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
BOARD OF  
PATENT APPEALS AND INTERFERENCES

In re Application of: Michael J. Dove

Serial No.: 10/053,292

Filed: January 23, 2002

For: **TELESCOPING EXTENSION POLE WITH  
BUILT-IN TUBE END PROTECTION**

Group Art Unit: 3676

Examiner: Williams, Mark A.

Mail Stop: Appeal Brief-Patents  
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Please find included:

Appellant's Notice of Appeal;

Appellant's Appeal Brief beginning on page 2 of this correspondence and consisting of  
15 pages numbered 2-16; and

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VA 22313-1450 [37 CFR 1.8(a)].

Michael J. Dove

Date

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### **Appeal Brief**

#### **(i) Real Party of Interest**

The real party of interest for purposes of the appeal filed herewith is Michael J. Dove.

#### **(ii) Related Appeals and Interferences**

This is an appeal from the final rejection of the Examiner dated September 9, 2005. A prior Notice of Appeal was filed on November 22, 2004, and an Appeal Brief was filed on January 19, 2005. No action by the Board was taken as the Examiner reopened prosecution.

#### **(iii) Status of Claims**

January 23, 2002      The application was filed with three (3) claims of which Claim 1 was independent.

August 15, 2003      In a Non-Final Office Action all of the claims were rejected.

February 15, 2004      In Appellant's response, Claims 1-3 were amended and new Claims 4-8 were added.

May 21, 2004      In a Final Office Action the Examiner rejected Claims 1-8. In addition, the Examiner objected to the drawing filed on January 23, 2002, however, replacement drawings were filed with Appellant's response dated February 15, 2004.

August 23, 2004 Appellant filed a response after final rejection. Claims 1-4 were cancelled, Claim 5 was amended, and Claims 9-16 were added.

November 18, 2004 An Advisory Action indicated that for purposes of Appeal, the amendments filed on August 23, 2004 would not be entered. However, in a subsequent telephone communication, the Examiner indicated otherwise.

November 22, 2004 Appellant filed a Notice of Appeal.

December 22, 2004 As indicated in a subsequent Examiner's Advisory Action, the proposed amendments as contain in Appellant's response dated August 23, 2004, to the aforementioned Examiner's final rejection dated May 21, 2004, would be entered for purposes of the Appeal.

January 19, 2005 Appellant filed an Appeal Brief. Claims 5-16 as contained in Appellant's response dated August 23, 2004 were the subject of that appeal.

April 19, 2005 In a Non-Final Office Action, the Examiner rejected Claims 5-16.

June 14, 2005 Appellant filed a response to the Non-Final Office Action. Claims 5, 8, 9, 12, 13, and 16 were amended, and Claim 7 was cancelled.

September 9, 2005 In a Final Office Action, the Examiner rejected Claims 5, 6, and 8-16.

Accordingly, Claims 5, 6, and 8-16 are the subject of the appeal.

**(iv) Status of Amendments**

Claims 5, 6, and 8-16 stand rejected and are the claims being appealed.

**(v) Summary of Claimed Subject Matter**

The present invention is directed to an extension pole assembly for a tool such a paint roller or similar apparatus. (paragraph 004, lines 1-2) The extension pole assembly includes a plurality of pole segments configured substantially the same. (paragraph 004, line 7) The pole

segments are connected together in such a way so that as each successive pole segment is joined together (or as each joined pole segment is removed) an extension pole assembly having a protective end cap is formed without removal of the protective end cap of any other pole segment. (paragraph 008, lines 8-9)

As shown in Figure 1, each pole segment includes a first hollow cylindrical end portion 20 and a second hollow cylindrical end portion 30 having an external diameter 30a smaller than the internal diameter 20a of the first end portion 20. (paragraph 006, lines 3-7) The second end portion 30 preferable includes a protective cap 34 inserted therein. (paragraph 008, lines 4-5) Accordingly, every pole segment has an end cap placed into the smaller diameter end portion.

When desiring to form a pole having a length longer than what currently exists, the second end portion 30, that is the smaller diameter end 30a having a protective cap 34 inserted therein, of the first pole segment (segment of the existing extension pole) is received into a first end portion 20, that is the larger diameter end 20a, of a second pole segment (segment added to extend the pole). (paragraph 006, lines 5-8) The first end 20 or larger diameter portion of the very first pole segment will typically have a paint roller, scrapper, brush, duster, or some other utility attachment connected. (paragraph 009, lines 1-3) As each pole segment, configured substantially the same, is connected, an extension pole assembly having a protective cap 34 is formed without removal of the protective end cap 34 of the first pole segment or any other pole segment. (paragraph 008, lines 8-9)

Alternatively, when desiring to form a pole having a length shorter than what currently exists, removal of each successively added pole segment results in a pole assembly having a protective end cap 34 without removal, replacement, exchange, or substitution of any other protective end cap 34.

**(vi) Grounds of Rejection**

**35 U.S.C. §112, second paragraph**

Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 9, the Examiner alleges, “the extension pole is formed with the cap of the second pole segment formed without removal of the cap” is not understood in the context of the claimed invention.

In Claim 13, the Examiner alleges, “ the extension pole is formed with the cap of the last pole segment added formed without removal of the cap. . .” is not understood in the context of the claimed invention.

In regard to both Claims 9 and 13, the Examiner further contends that those claims almost appear to be a method step.

**35 U.S.C. §103**

In regard to Appellant’s claimed invention including end cap, Claims 5, 6, 8-10, 12-14, and 16 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent No. 2,712,950, issued to Siebert in view of U.S. Patent No. 6,557,572, issued to Lah.

In regard to Appellant’s claimed invention including locking mechanism, Claim 11, and 15 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Siebert ‘950 in view of Lah ‘572, and further in view of U.S. Patent No. 5,779,386 issued to Eichhorn.

## **(vii) Arguments**

Of the above-referenced claims, Claims 5, 9, and 13 are independent. Once patentability of those claims is established, all claims depending therefrom are likewise allowable.

Accordingly, the remarks set forth below focus primarily on those independent claims.

### **CLAIM REJECTIONS – 35 U.S.C. §112, second paragraph**

The Examiner's focus during examination for definiteness "is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." "In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of its scope . . ." MPEP §2173.02 (8<sup>th</sup> ed. 2004)

In this regard, if the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention, and if the language is as precise as the subject matter permits, the claims are definite under Section 112, second paragraph. Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir.), *cert. dismissed*, 474 U.S. (1985).

No limitation has been placed on how an applicant claims his invention, so long as the specification concludes with claims which particularly point out and distinctly claim that invention. In re Pilkington, 411 F.2d 1345, 1349-50, 162 USPQ 145 (C.C.P.A. 1969).

As indicated above, the examiner must consider the claim as a whole in view of the specification to determine whether the claim appraises one of ordinary skill in the art of its scope. In both Claims 9 and 13, the Examiner has identified a small section of text in what should be considered, and thus becomes clearer, in the context of a larger section of text.

For example, in rejecting Claim 9, the examiner alleges the phrase “the extension pole is formed with the cap of the second pole segment formed without the removal of the cap” is not understood in the context of the claimed invention. If that phrase is expanded to read “so that the extension pole is formed with the cap of the second pole segment formed without removal of the cap from the first pole segment” (emphasis added) it becomes abundantly clear that the phrase is stating a desired end result based on the structural relationship of the elements recited earlier in the claim. The phrase merely explicitly states what was already implicitly stated in the claim. Actually, the phrase “so that . . . segment” can be removed without changing the scope of the claim. In this regard, if a person were to join together pole segments configured substantially the same, e.g. a smaller external diameter segment having an end cap inserted therein received into a larger internal diameter segment, he/she would find, without being told explicitly, that an extension pole is formed with the cap of the second pole segment formed without removal of the cap from the first pole segment.

Accordingly, Appellant respectfully submits that Claim 9, and likewise for the same reasoning Claim 13, when considered as a whole and read in view of the specification are sufficiently clear to reasonably apprise those skilled in the art of the use and scope of the invention.

In regard to the Examiner’s statement that Claims 9 and 13 “almost appear[s] to be a method step” (emphasis added), it is unclear how Appellant is to respond to this or any almost statement. Accordingly, Appellant believes the statement to be indefinite for failing to particularly point out and distinctly recite a rejection.

## CLAIM REJECTIONS - 35 U.S.C. §103

Appellant respectfully submits that Siebert in combination with Lah and/or Eichhorn does not disclose a pole arrangement/assembly having a plurality of pole segments configured substantially the same in which:

- (1) each pole segment includes first and second tube portions of different size diameters;
- (2) the smaller diameter tube portion of each pole segment has a end cap inserted therein:
- and
- (3) the smaller diameter tube portion having the end cap is received into the larger diameter tube portion such that an extension pole arrangement/assembly having an end cap is formed without removal of the end cap from any other pole segment. **(Claim 5, 9, and 13)**

Accordingly, when assembling or disassembling Appellant's extension pole, the only way for all three conditions, that is, to have an extension pole terminate with an end cap inserted into a smaller diameter end, is to have the smaller diameter tube portion of an existing pole segment received into the larger diameter tube portion of an added pole segment.

### Claims 5, 9, and 13

The Siebert device requires insertion of a smaller diameter end (dowel) 10 of an added pole segment into a larger diameter end (socket) 11 of an existing pole segment in order to lengthen the device. As indicated in Siebert, "The sections 7, 8, and 9 are provided with dowel portions 10 at one end and the sections 6, 7, and 8 have socket portions 11 adapted to telescopingly receive the dowel portions 10. The section 9 is the outer or top section and has a closure cap 12 . . . One end of each section 7, 8, and 9 is reduced . . . to provide the dowel 10 . . ." (Column 2, lines 18-29) Thus, the Siebert device terminates with a closure cap in the larger diameter section of tubing. This arrangement (extension pole ending in an enlarged end) is

achieved, as shown in FIGURE 2 (corresponding in cross-section to Figure 1) by having the dowel 10 (reduced diameter end) of an added pole section 7, received in the socket 11 (larger diameter end) of existing pole section 6.

In contrast, lengthening Appellant's pole assembly requires that a smaller end of a leading or first tube (existing) having an end cap be insert into the larger diameter of the tube being added to the assembly. In other words, Siebert teaches insertion of a smaller diameter pole into a larger diameter existing pole in order to lengthen the extension assembly. On the other hand, Appellant's invention teaches positioning of a larger diameter pole over the smaller diameter end of an existing pole in order to lengthen the extension assembly and to form an extension pole having an end cap formed without removal of the end cap from any other pole segment.

Siebert simply does not disclose Appellant's invention. Furthermore, there is no teaching, suggestion, or motivation in Siebert that would lead one skilled in the art to redesign the handle of Siebert's device. Siebert states, "I have not attempted to illustrate or describe other embodiments as it is believed that this disclosure will enable those skilled in the art to embody the invention as may be desired." (Column 3, lines 25-29) It would not have been obvious to reconfigure the Siebert device so that it is totally opposite to what is taught by the Siebert disclosure and then add end caps 90, as allegedly disclosed by Lah, to the dowel portions of every pole in order to achieve Appellant's invention.

In this regard, it is far too simplistic to suggest that, "It would have been obvious at the time the invention was made for one skilled in the art to have included in the design of Siebert such a modification, for the purpose of providing a buffering structure that would prevent damage to other pole elements." (Examiner's Office Action, page 3, Section 4, second paragraph)

Such a modification of Siebert would involve reversing pole segment diameters to achieve larger diameter end over smaller diameter end connectivity between tool segments instead of smaller diameter end into larger diameter end connectivity. In addition to reversing the end diameter of each pole segment, with an end cap inserted into the dowel end, Siebert would have to redesign the connection assembly in order to operate properly in the new design. In this regard, an end cap inserted into Siebert's dowel end 10 would block the open end of the longitudinally extending groove 13 formed by inseting a portion 14 of the wall of the dowel. (Column 2, lines 33-35) The groove being necessarily open to receive lug 19 formed on the socket end would become blocked by the addition of an end cap. (Column 3, lines 3-5)

In this regard, Appellant, recognized that the small inconvenience posed by an exposed push button latch mechanism in the end of the extension pole assembly would be far outweighed by the added benefit, as described below, of having a permanently attached protective end cap. As indicated above, Siebert did not envision, much less teach, how such a reverse arrangement might have worked.

In view of the simplicity of Appellant's invention it may have been difficult for the Examiner not to use the claimed invention as an instruction manual or "template" to arrive at Appellant's invention. However, failure to provide to necessary suggestion or motivation will create a presumption that the combination of references selected by the Examiner to support the obviousness rejection were based on impermissible hindsight.

Appellant's pole assembly configuration allows a pole segment to be added to the existing pole assembly without removal of the protective end cap 34 from the smaller end portion 30 of the existing segment as this smaller end portion 30 is inserted into or received into the larger end portion 20 of a tube segment being added to the existing pole assembly. Accordingly,

Appellant's invention provides for the formation of an extension pole assembly (extending by the addition of a pole segment) having a protective end cap 34 formed therein without the addition or removal of the protective end cap from any other pole segment. (Claims 9 and 13).

Likewise, shortening of the pole assembly by removal of a pole segment exposes the smaller end portion 30 having a protective cap 34 already inserted therein.

In contrast to Applicant's invention, the Siebert configuration would require the removal of any protective end cap deemed applicable from Lah from the existing pole assembly's larger diameter end 36 before the smaller end 34 of a pole segment to be added could be inserted to the larger end 36 portion to lengthen the pole assembly.

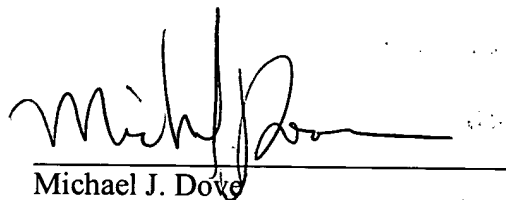
In this regard, Appellant's invention is a significant departure from the prior art. As each successive pole segment is joined together an extension pole assembly having a protective end is formed without removal of the protective end cap of any other pole segment. Consequently, the extension pole assembly will always have a protective end cap, removal of the end cap from one pole segment and the insertion of the same end cap into another pole segment is negated, and the possibility of losing end caps or damage to the surrounding environment by an unprotected end of a pole segment is negligible. Simply adding an end cap to Siebert does not result in Appellant's invention.

Appellant respectfully disagrees with the Examiner's assertion that Lah discloses an end cap as claimed by Appellant. In this regard, Lah provides a finishing member 90 that performs a buffering action when two pole segments 50, 60 are removed from each other. The finishing member 90 includes a through hole 91 to allow passage of an elastic cord 20, and external surfaces having streamlined convex portions 92. (Column 3, lines 40-47) Appellant is unaware of any end caps currently available that include a center hole and an elastic cord passing

therethrough. This type of finishing member 90 set-up tends to teach away from the concept of something that terminates or ends other object, i.e., end cap, as the presence of the elastic cord in Lah's device continues or extends to other pole segments. As shown in Figures 5-7, Lah further discloses at least three alternative embodiments of the finishing member 90. In this regard, as one progresses from Figure 5 to Figure 7, any structural resemblance the finishing member 90 of Figure 5 may have to an end cap is totally obscured by the finishing member 90 embodiment of Figure 7. Lah does not teach Appellant's end cap. What Lah does teach is that by providing external surfaces having a streamlined convex portion 92 the finishing member 90 is able to perform "a buffering action when the end portions of the tent poles 50 and 60 collide against each other, thereby preventing the end portions of the tent poles 50 and 60 from being damaged by colliding against each other." (Column 3, lines 66 and 67; and Column 4, lines 1-3). Appellant respectfully submits that the previous structural description in no way, shape, or form describes an end cap.

In view of the remarks set forth above, Appellant respectfully submits that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,



Michael J. Dove

Dated: September 30, 2005

**(viii) Claims Appendix**

5. An extension pole arrangement comprising successively joined pole segments, each pole segment being substantially identical and comprising:

first and second tube portions, the first tube portion extending longitudinally from the second tube portion and terminating with an end cap;

the second tube portion having an open end with an inside diameter greater than the outside diameter of the first tube;

wherein the first tube portion of a first pole segment is received into the second tube portion of a second pole segment, so that the extension pole is formed with the end cap of the second pole segment formed without removal of the end cap from the first pole segment;

the first tube portion including a locking mechanism configured for coaxing mating engagement with an aperture in said second tube portion for receiving said locking mechanism.

6. The extension pole arrangement of Claim 5, wherein said second tube portion is of substantially reduced length comparable to said first tube portion.

8. The extension pole arrangement of Claim 5, wherein the end cap is a resilient insert compressibly mounted into the first tube portion and protruding outward therefrom.

9. An extension pole assembly, comprising:

a first pole segment including:

a first hollow cylindrical end portion; and

a second hollow cylindrical end portion having an external diameter smaller than the internal diameter of the first end portion, and having a cap inserted therein;

wherein the second end portion of the first pole segment is received into a first end portion of a second pole segment, the second pole segment configured substantially the same as the first

pole segment so that the extension pole is formed with the cap of the second pole segment formed without removal of the cap from the first pole segment.

10. The extension pole assembly of Claim 9, wherein the second end portion of the first pole segment and the first end portion of the second pole segment are removably connected by a locking mechanism positioned therebetween.

11. The extension pole assembly of Claim 10, wherein the locking mechanism comprises an aperture positioned on the first end portion of the second pole segment for receiving a spring mounted push button positioned on the second end of the first pole segment.

12. The extension pole assembly of Claim 9, wherein the cap protrudes beyond the end of the second end portion and is held in place by compression.

13. An extension pole assembly, comprising:

a plurality of pole segments configured substantially the same and capable of being joined together, each pole segment having a first hollow end portion; and

a second hollow end portion having an external diameter smaller than the internal diameter of the first end portion, and having a cap inserted therein;

wherein the second end portion of one pole segment is received into a first end portion of a different pole segment so that after each successive pole segment is joined together the extension pole is formed with the cap of the last pole segment added formed without removal of the cap of any other pole segment.

14. The extension pole assembly of Claim 13, wherein the second end portion of one pole segment and the first end portion of a different pole segment are removably connected by a locking mechanism positioned therebetween.

15. The extension pole assembly of Claim 14, wherein the locking mechanism comprises an aperture positioned on the first end portion of one pole segment for receiving a spring mounted push button positioned on the second end of a different pole segment.
16. The extension pole assembly of Claim 13, wherein the cap protrudes beyond the end of the second end portion and is held in place by compression.

**(ix) Evidence Appendix**

None

**(x) Related Proceedings Appendix**

None